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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,773	11/16/2001	Anne Robert	ESSR:057US	5899

7590 06/02/2003

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	11

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/991,773	ROBERT ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *March 24, 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-18 and 20-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-18,20-22,24,25 and 27-30* is/are rejected.

7)☒ Claim(s) *23 and 26* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This office action follows a response filed on March 24, 2003. Applicants have amended claims 13, 20, and 30. Claim 19 was canceled.

1. The indicated allowability of claims 14-16, 20, 24, 25, and 29 is withdrawn in view of the newly discovered reference(s) to U.S. 2002/0128339 to Maisonnier *et al.* and U.S. Patent No. 5,731,379 to Kennan *et al.* Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 13-18, 20-22, 24, 25, 27, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0128339 to Maisonnier *et al.*

Maisonnier *et al.* teaches a method of preparing a photochromic latex comprising (1) preparing an aqueous emulsion of at least one monomer Z and at least one photochromic chromene compound and (2) polymerizing in the presence of water soluble initiator (*i.e.*, polymerization primer) to obtain the photochromic latex. The reference is silent with respect to the details of the aqueous emulsion of step (1). Although the text omits any reference to the term miniemulsion, the skilled artisan would have reasonable basis to believe that the process described in Maisonnier *et al.* is essentially the same as that recited in present claim 13 and 20. Such a notion is obvious in view of the fact that both processes use the same materials to produce latices having the same particle size (Maisonnier *et al.*, claim 11; Robert *et al.*, paragraph [0035]). Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 14-18 are obvious to one having skill in the art since Maisonnier *et al.* indicates that polymerization takes place in the presence of initiator. That is, the initiator is already present in the emulsion prior to polymerization or it is added during polymerization (*as per* claim 4). The skilled artisan would find it obvious to arrive at the limited permutations of manipulations recited in the claims to satisfy the condition that polymerization occurs in the presence of initiator. Also, the example teaches degassing prior to addition of primer (paragraph [0113]).

Since Maisonnier *et al.* illustrates use of a chromene as the photochromic compound and an alkyl (meth)acrylate as monomer Z (claims 1 and 9), one having ordinary skill in the art would find it obvious to use these materials in order to arrive at the subject matter of present claims 21 and 22. Claim 27 is obvious since the skilled artisan would appreciate that the initiator must be soluble in at least one phase in order to effect polymerization. Regarding claim 28, sodium persulfate and 2,2'-azo*bis*(2-amidinopropane) dihydrochloride initiators are shown in the reference to be useful initiators (claim 6 and paragraph [0059]). Hence, the skilled artisan would find it obvious to use these particular materials. Claims 24 and 25 are obvious over the teachings of the reference because the use of surfactants is discussed in paragraph [0068] and because the examples show the use of DISPONIL® (mixture of fatty alcohols) surfactant for stabilizing the latex.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maisonnier *et al.* in view of U.S. Patent No. 5,731,379 to Kennan *et al.*

While Maisonnier *et al.* is silent with respect to the details of the aqueous emulsion, Kennan *et al.* teaches formation of miniemulsions using a microfluidizing apparatus in which the resultant emulsion contains particles on order of 50-500 nm. Furthermore, the reference teaches all manipulative features of the present claims with respect to formation of miniemulsions. Thus, one having ordinary skill in the art, having read the contents of both patents, would find it obvious to use a microfluidizing apparatus to prepare emulsions described in Masionnier *et al.*

6. Claims 23 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following have been overcome by amendment:

(*i*) Provisional rejection of claims 13, 18, 19, 21, 22, 27, and 28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 9, and 11 of copending Application No. 09/939,151.

(*ii*) Provisional rejection of claims 13, 18, 21, 22, 27, and 28 under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/939,151.

(*iii*) Rejection of claims 13, 17, 18, 21, 22, 27, and 28, 30 under 35 U.S.C. 102(e) as being anticipated by U.S. 2002/0128339 to Maisonnier *et al.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

May 28, 2003

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700